

## R E M A R K S

### **A. INTRODUCTION**

Claims 60, 73-89, 91-114 and 116-121 are pending.

Claims 60, 73-81, 88, 96-103, 105 and 116-121 are rejected.

The Office Action does not address Claim 111—it is not clear whether Claim 111 is rejected or allowed.

Claims 82-87, 89, 91-95, 104, 106-110 and 112-114 are withdrawn.

Appellants respectfully request a Pre-Appeal Brief Review of the current grounds of rejection in order to correct the clear errors described below.

### **B. CLAIM 111: NOT WITHDRAWN BUT NOT EXAMINED**

Claim 111 is pending and is not withdrawn. The present Office Action does not address Claim 111. Accordingly, its current status (allowed or rejected) is unclear. Appellants respectfully request that a new Office Action be provided that indicates the status of pending Claim 111.

### **C. SECTION 112 ¶ 2 REJECTION: SCOPE OF “SPONSORING ORGANIZATION” IS REASONABLY CLEAR AND DESCRIBED IN SPECIFICATION**

Claims 60, 73-81, 88, 96-103, 105 and 116-121 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which we regard as the invention.

The Examiner finds:

The limitation “sponsoring organization” is vague and indefinite as to what the organization is sponsoring and where the line of delineation between the sponsoring organization and the credit providing (e.g. bank) organization).

[Office Action, page 2]. Appellants traverse this finding, and respectfully submit that the term “sponsoring organization” is reasonably clear on its face and when considered, as required, in light of the Specification.

“If the claims when read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.” Miles Laboratories, Inc. v. Shandon, 997 F.2d 870, 875 (Fed. Cir. 1993); see also, S3 Inc. v. nVIDIA Corp., 259 F.3d 1364, 1367 (Fed. Cir. 2001).

The claims need set out and circumscribe a particular area with only a reasonable degree of precision and particularity. In re Moore, 58 C.C.P.A. 1042, 1046-1047 (C.C.P.A 1971). It is impermissible in law to apply the “full, clear,

concise, and exact" requirement of the first paragraph of § 112 to a claim, when that paragraph applies only to the disclosure portion of the specification, not to the claims. Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1575-1576 (Fed. Cir. 1986) (citing Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 453, 227 (Fed. Cir. 1985)). See also, MPEP § 2173.02 ("Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.").

The Examiner suggests that the claim language must specify "what the organization is sponsoring" in order to be definite under Section 112, paragraph 2. Applicants disagree that such specificity is required; however, Applicants note that the rejected independent claims recite that the sponsoring organization offers to activate a line of credit or offers a credit line to a customer.

The Examiner suggests that the claim language is unreasonably unclear because no proper "line of delineation" is made between "sponsoring organization and the "credit providing...organization." Appellants respectfully disagree. Appellants claims are supported by, and form a part of, a written Specification describing, among other things, a sponsoring organization (using that exact term approximately 50 times) and distinguishing such entities from credit providers (another term recited in the present claims). See, e.g., FIGs. 1A and 1B; Introduction. Appellants respectfully suggest the Examiner consider the Specification, as required for Section 112, second paragraph analysis. As no mention is made of the Specification, and there is no articulated argument as to why the description of "sponsoring organizations" fails to provide even a reasonable degree of clarity, no prima facie case of indefiniteness has been established. Further, the "delineation" is clear in each claim from the respective subject matter as a whole, which also must be considered. An indication of a line of credit, for example, is obtained from a credit provider, whereas a sponsoring organization offers the line of credit to a customer.

For at least these reasons, Appellants submit that the Section 112, second paragraph, suffer from clear error, and respectfully request those rejections be withdrawn.

#### **D. SECTION 103(A) REJECTIONS**

Claims 60, 73-81, 88, 96-103, 105 and 116-121 stand rejected under 35 U.S.C. 103(b) as being unpatentable over Spivak ("Instant Money") or "record". [Office Action, page 2]. Appellants respectfully traverse the Examiner's Section 103(a) rejection.

## **1. Rejection over “record” lacks proper notice under Section 132**

35 U.S.C. § 132 establishes the threshold amount of information that must be provided when a claim is rejected upon examination. “Section 132 merely ensures that an applicant ‘at least be informed of the broad statutory basis for [the rejection of] his claims, so that he may determine what the issues are on which he can or should produce evidence.’ In re Hughes, 52 C.C.P.A. 1355, 345 F.2d 184, 185, 145 USPQ 467, 468 (1965). Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” Chester v. Miller, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (substitution in original, citation omitted).

With the rejection over “record” the Examiner fails to provide proper notice of rejection under Section 132. Appellants cannot discern the actual (alternative?) grounds of rejection for a Section 103(a) based on “record.” In referring so ambiguously to “record,” the Examiner does not specify exactly which claims are rejected under exactly what prior art. All of the rejections based on “record” fail under Section 132 because they are so uninformative that they prevent Appellants from recognizing and seeking to counter the grounds for rejection. Appellants are not given adequate notice as to the actual reasons for rejection, nor are Appellants given the information and references required to determine the propriety of continuing the prosecution of this application. Appellants respectfully request that the grounds of rejection under Section 103(a) based on the so-called “record” be withdrawn.

## **2. Rejections over Spivak**

Appellants respectfully submit that nothing in ¶¶ 11 – ¶ 13 (or otherwise in Spivak) teaches or suggests a combination of features that includes (1) receiving an indication that a line of credit has been established for a customer expected to arrive at a particular location of a sponsoring organization (in which the customer has not solicited the line of credit), (2) offering the line of credit at the same location, and (3) activating the line of credit with a chargeable event at the same location.

To the contrary, in Spivak the only indication of an unsolicited line of credit, or an offer for such, is a “bank credit card” sent unsolicited by mail to a customer. ¶ 12. Contrary to the Examiner’s prior assertion with respect to Claim 115 (now cancelled), there is no hint or suggestion in Spivak of activating the unsolicited bank credit card at the location it is mailed to (i.e., the customer’s mailing address). Further, there is no hint or suggestion of providing an indication of an unsolicited line of credit established for a customer to a location of a sponsoring organization

at which the customer is expected to arrive, much less offering the unsolicited line of credit at that same location.

The Examiner asserts that Spivak “[t]aken in its entirety” teaches “to offer a revolving lines of credit to the customer while the customer is in the store.” Spivak simply cannot be “taken in its entirety,” by which the Examiner means its teachings can be parsed out and reassembled conveniently but in a manner contrary to and discouraged by those same teachings.

Spivak discusses new types of credit offerings by banks (bank credit cards and check credit). An “investigation” carried out is by the issuing bank, and it is the bank who sends a bank credit card unsolicited by mail. ¶ 12. Therefore, Spivak does not teach or suggest a “retail store” providing a customer an unsolicited credit line offer, much less to a customer expected to arrive at that “retail store.”

The Examiner has not shown that Spivak, or any general knowledge of one of only ordinary skill in the art at the time of the present invention, suggests *after obtaining an indication of a line of credit from a credit provider, a sponsoring organization then offering a credit line, offering to activate a line of credit, or offering a credit card, to a customer while the customer is at a location of sponsoring organization.*

The Examiner does not offer any reference or other evidence, assertion of what was generally known in the art, or hint of prevailing market forces at the time of invention, as teaching or suggesting *then offering a credit line to a customer while the customer is at a location of a sponsoring organization.* The Examiner simply asserts, in effect, that it is a good idea. Appellants do not disagree it is a good idea; however, they maintain that their good idea is not taught or suggested by any evidence or argument made of record in this application. The Examiner continues to rely upon impermissible hindsight and the clearly persuasive roadmap of the Specification to backfill a basis for rejection under Section 103(A).

The Examiner asserts: “It would have been obvious for one skilled in the art at the time to have offered the card to shoppers while at the sponsoring location as motivated by the need to reduce the risk of credit theft and or to increase the likelihood that the customer be aware that credit has been preapproved for the customer.” [Office Action, page 4]. Neither alleged motivation is supported by the record or, if it were, would suggest all of the claimed subject matter of any pending claim.

Assuming that “risk of credit theft” was a consideration known to one of only ordinary skill in the art, the Examiner does not attempt to articulate any reasoning as to why such a consideration would motivate one to offer a credit line to a

customer while the customer is at a location only after obtaining an indication of the line of credit established for the customer. The rejection fails for at least this reason.

In particular, the Examiner does not explain why it would be less risky to obtain first an indication of a line of credit established for a customer (e.g., receive a credit card or other information identifying or indicating a credit line) before offering the line of credit to the customer, as opposed to, for example, first offering a customer a store line of credit and only then establishing the line of credit (as was known at the time of the present invention). The implementation proposed by the Examiner would, presumably, increase this “risk of credit theft”. Accordingly, that suggested and unsupported motivation cannot establish a prima facie case of obviousness of any of the pending claims.

Also, the alleged motivation to increase the likelihood that the customer be aware that credit has been preapproved for the customer would seem to teach away from and unnecessarily complicate what is actually described in Spivak, which is mailing unsolicited offers directly to recipients’ homes.

The Examiner has not shown that Spivak teaches or suggests *activating a credit line as part of a chargeable event at the location of the sponsoring organization at which the customer was expected*.

Also, although required to do so in order to support a Section 103 rejection under Graham v. Deere, the Examiner has not set forth any evidence relating to the level of ordinary skill in the art at the time of invention, and has not even alleged what the level of ordinary skill in the art would be.

#### **E. CONCLUSION**

It is submitted that all of the claims are in condition for allowance. The Examiner’s consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at [mddowns@walkerdigital.com](mailto:mddowns@walkerdigital.com).

Respectfully submitted,

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